

Paper No. 8
THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 29,00

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U. S. PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mediterranean Classics Incorporated

Serial No. 75/410,673

Walter D. Ames of Watson Cole Grindle Watson for Mediterranean Classics Incorporated.

Tricia L. Sonneborn, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney)

Before Simms, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, Mediterranean Classics Incorporated, a Tennessee corporation, has filed an application for registration of the mark "COOKMARKS" for "bookmarks having recipes and other gastronomically related subject matter printed thereon" in International Class 16.¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, "COOKMARKS," when used on its bookmarks, so resembles the registered mark,

"COOKBOOKMARK" for bookmarks, as to be likely to cause confusion, or to cause mistake, or to deceive.²

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that the registered mark, "COOKBOOKMARK," is generic for bookmarks for cookbooks, and hence should be entitled to practically no protection. By way of contrast, applicant contends that its mark, "COOKMARKS," is suggestive for bookmarks for cookbooks. Applicant concludes that these two marks are different as to sound, appearance and meaning.

The Trademark Examining Attorney, in turn, takes the position that these two marks are highly similar as to sound, appearance and overall commercial impression, and furthermore, that they are being used in connection with identical goods.

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth factors which must be considered, if relevant, in determining likelihood of confusion.

Under Section 2(d) of the Act, we must compare applicant's trademark, "COOKMARKS," with registrant's trademark,

¹ Serial No. 75/410,673 filed on December 24, 1997 alleging first use on March 27, 1997.

"COOKBOOKMARK." The Trademark Examining Attorney takes the position that:

... [T]he commercial impression of the marks is quite similar given the goods, bookmarks. Both marks are a clever play on "cookbook" and "bookmark." The registrant chose to fully telescope the words by using the common word "book," while applicant combines a part of each word to form its mark. Either way, the marks are extremely similar in appearance, sound and commercial impression. (Final refusal, p. 2).

We agree. One can hardly speak or read the mark "Cookmarks" without thinking of the quite familiar word "bookmarks." Of course, "...bookmark" is literally part of registrant's telescoped mark, "Cookbookmark." Hence, that the goods should be bookmarks for cookbooks readily flows from the suggested meanings of both of these coined marks.

Applicant has repeatedly taken the position -- during the prosecution of this application before the Trademark Examining Operations and again during this *ex parte* appeal before the Board -- that the registered mark is generic and should not have been registered. However, Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark

² Registration No. 1,337,877 issued on May 28, 1985. The registration sets forth dates of first use of July 15, 1984.

in commerce in connection with the goods or services specified in the certificate. Accordingly, during this *ex parte* prosecution, applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., that the mark is unenforceable because it is generic). See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); Cosmetically Yours, Inc. v. Clairol Inc., 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); In re Pollio Dairy Products Corp., 8 USPQ2d 2012, 2014-15 (TTAB 1988).

In any event, notwithstanding any alleged weakness in the cited mark, even weak marks are entitled to protection against the registration by a subsequent user of a substantially similar mark for closely related or identical goods.

Finally, we agree with the Trademark Examining Attorney that these goods must be deemed to be identical.

Decision: The refusal to register is hereby affirmed.

R. L. Simms

P. T. Hairston

D. E. Bucher

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Administrative Trademark
Judges, Trademark Trial and
Appeal Board